

REMARKS

Claims 1, 3 and 4 have been rejected under 35 U.S.C. 102(e) as being anticipated by Koeske et al. (US 6,250,613).

Claims 5-6 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Koeske et al.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koeske et al. in view of Geno et al. (US 4,946,144).

Claims 9-11 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koeske et al.

All of the above rejections depend on Koeske et al as the primary reference. Amended claim 1 now recites that the retainer (8) has an integrally formed intermediate ribbed reinforcement structure, similar to that claimed in previously added claim 9.

As the separator plate of Koeske is *not* integrally formed, Koeske is no longer an anticipatory reference for claim 1 and the relevant rejection is that set forth for claim 9.

In the rejection of claim 9, it is stated that the courts have ruled that providing a one-piece construction "would be merely a matter of obvious design choice" *in re Larson*, 144 USPQ 347 (CCPA 1965). While there are certainly instances where it would be an obvious design choice to combine elements to form them in a unitary manner, one must also look at the exact elements and what the prior art teaches regarding those elements and why the prior art teaches forming the parts separately.

Koeske teaches that a problem with air springs is the "wide variety of shapes and sizes to fit the numerous suspension system configurations" and that manufacturers are "forced to provide each air spring configuration in a variety of heights and diameters so that each suspension application falls within the design envelope of at least one air spring assembly." (col 1, lines 46-53). The use of separate spacers, to be combined with an airspring thus expands the "design envelope of the air spring assemblies." Koeske teaches that the "spacers thus allow the manufacturer to decrease the total number of air spring configurations in its inventory and manufacturing line." (col 1, lines 57-60). The implication also being that if the air spring as designed by a manufacturer meets the suspension configuration, no spacer is needed.

To convert the spacers into an integral part of the air spring retainer, as asserted in the Office Action, would remove the taught benefit of having a separate spacer. One of the

benefits of having a separate spacer is the possibility of not needing one for a particular suspension configuration. Were the airspring of Koeske modified to provide an integral spacer, than that flexibility is removed and the manufacturer is one again forced to increase the number of air spring configurations available for each suspension system configuration.

Thus to form the retainer and the spacer of Koeske as an integral component would be contrary to the expressed goals of Koeske. 'We have noted elsewhere, as a "useful general rule," that references that teach away cannot serve to create a *prima facie* case of obviousness. *In re Gurley*, 27 F.3d 551, 553, 31 U.S.P.Q. 1131, 1132 (Fed. Cir. 1994). While there is no specific second reference employed in making this rejection, *in re Larson* may be considered to be the second reference providing the motivation to modify Koeske. Herein, in context of *in re Gurley*, Koeske specifically teaches the necessity to have separate elements while *in re Larson* teaches forming a unitary article, thus they cannot be combined.

When using a reference in a prior art rejection, the prior art must be considered in its entirety, including any disclosures that teach away from the claim. *See W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d, 220 USPQ 3030 (Fed. Cir. 1983), *cert. Denied*, 469 U.S. 851 (1984), see also MPEP 2141.02. Herein Koeske specifically teaches away from forming the spacer and any part of the air spring as a unitary article. These teachings cannot be ignored.

Under *Graham v. Deere*, to establish *prima facie* obviousness, there 1) must be some suggestion or motivation in the art to modify or combine the references; 2) must be a reasonable expectation of success and 3) the combined references must teach or suggest all the claim limitations.

While *in re Larson* provides motivation to modify Koeske, the courts have held, as argued above, that as the teachings are opposing and the primary reference specifically provides reasoning as to why the spacer should not be combined, these references cannot be combined under *Graham v. Deere*.

It is respectfully requested that the rejection of the claims over Koeske as modified in the Office Action be reconsidered and withdrawn.

In light of the amendment and the arguments set forth, Applicant believes the claims now pending in the subject patent application are in condition for allowance. The Examiner is respectfully requested to indicate allowability of all the pending claims.

Respectfully submitted,

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